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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,493	05/05/2006	Laurent Desire	67987.000002	7885
21967 7590 04/17/2009 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			EXAMINER CHERNYSHEV, OLGA N	
			ART UNIT 1649	PAPER NUMBER
			MAIL DATE 04/17/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/578,493

**Applicant(s)**

DESIRE, LAURENT

**Examiner**

Olga N. Chernyshev

**Art Unit**

1649

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 April 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-14 and 19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 12-14 and 19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Individual Patent Application  
6) ☒ Other: copy of sequence alignment

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 03, 2009 has been entered.

### ***Response to Amendment***

2. Claim 12 has been amended as requested in the amendment filed on April 03, 2009. Following the amendment, claims 12-14 and 19 are pending in the instant application.

Claims 12-14 and 19 are under examination in the instant office action.

3. Any objection or rejection of record, which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

4. Applicant's arguments filed on April 03, 2009 have been fully considered but they are not deemed to be persuasive for the reasons set forth below. New grounds of rejection are set forth below as well.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 12-14 and claim 19 stand rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6,420,534, Gurney et al, ('534 patent) for reasons of record in section 17 of Paper mailed on March 28, 2008 and section 6 of Paper mailed on November 07, 2008.

At pp. 3-4 of the Response, Applicant submits that, "[c]laims 12-14 and 19 are drawn to an antibody, fragment, or derivative thereof, that binds a polypeptide comprising the amino acid sequence of SEQ ID NO: 3. Accordingly, the claimed antibody, fragment, or derivative thereof binds a polypeptide possessing at least SEQ ID NO: 3 - corresponding to the junction region between amino acids encoded by exons 3 and 5". Applicant further argues, "[t]he '534 patent discloses antibodies that bind to huAsp2(b) (SEQ ID NO: 6 of the '534 patent). HuAsp2(b) contains exon 4, and therefore exons 3 and 5 are not jobbed. As such, the '534 patent does not disclose a polypeptide comprising SEQ ID NO: 3, let alone an antibody, fragment, or derivative thereof, that binds a polypeptide comprising SEQ ID NO: 3". Applicant's arguments have been fully considered but are not persuasive for the following reasons.

As fully explained in the previous office action of record, the claims are interpreted using broadest reasonable meaning "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004)). Thus, the broadest reasonable interpretation of the instant claimed product of claim 1 is that it encompasses an antibody that binds to any epitope of a polypeptide comprising SEQ ID NO 3 meaning that the claimed genus of antibodies includes those that bind outside the SEQ ID NO: 3. Applicant is advised that the information disclosed in the specification, such what corresponds to junctions between the exons 3, 4, 5, joined or separated,

must not be read into the claim limitations. If it is Applicant's desire to claim that very specific molecular embodiment – an amino acid sequence which includes specific exons, junction etc. - defined by a particular structure, SEQ ID NO: , which in turn will define the antigenic specificity of the claimed antibodies, then that what must be recited in the claims. Currently, claim 1, as written, encompasses virtually any antibody and certainly the antibodies that bind to a polypeptide of SEQ ID NO: 2 recited in the dependent claims 14 and 15.

Applicant is further advised that claims 14 and 15, which recite antibodies that bind to a polypeptide comprising SEQ ID NO: 2, are currently presented as dependent from claim 1, and are considered to be properly dependent strictly because they recite polypeptides larger than the base claim (claim 1 is which is drawn to antibodies that bind to SEQ ID NO: 3, which is a fragment within SEQ ID NO: 2), If it is Applicant's position that claim 1 encompasses only antibodies that bind to SEQ ID NO: 3 exclusively, then claims 14 and 15 are improperly dependent claims for failing to narrow down the subject matter claimed within. (See MPEP § 608.01(n), "Infringement Test" for dependent claims. The test for a proper dependent claim is whether the dependent claim includes every limitation of the parent claim. The test is not whether the claims differ in scope. A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim).

Thus, since the '534 Patent teaches antibodies that bind to SEQ ID NO: 6, the amino acid sequence with 99.2% sequence similarity to the instant SEQ ID NO: 2, the claims 12-14 and 19 are fully anticipated.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 12-13 are rejected under 35 U.S.C. 102(e) as being anticipated by US

Patent 6,583,275, filing date of 1998, '275 Patent from hereafter.

Claims 12-13 are directed to antibodies that bind a polypeptide comprising SEQ ID NO:

3. The '275 Patent teaches a polypeptide comprising SEQ ID NO: 5205, which has 100% identity to the instant SEQ ID NO: 3, see copy of alignment attached to the instant office action. Further, the '275 Patent teaches antibodies that bind to the polypeptide of SEQ ID NO: 5205, see abstract and column 8, thus fully anticipating the instant invention.

### *Conclusion*

9. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (571) 272-0870. The examiner can normally be reached on 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey J. Stucker can be reached on (571) 272-0911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Olga N. Chernyshev, Ph.D.

April 15, 2009

/Olga N. Chernyshev/  
Primary Examiner, Art Unit 1649